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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,778	09/14/2000	MOTOSHI KISHI	106856	1551

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/13/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,778

Applicant(s)

KISHI ET AL.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed February 12, 2004 has been entered.

Drawings

2. As stated in the previous Office action, new corrected drawings that incorporate the approved corrections are required in this application (see paper no. 18, paragraph 2). The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112, 1st paragraph

3. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for “a drive unit that drives the switching device to switch the state of the cutter ... by moving the switching device to a cutting state position based on the proximity to a side wall of a frame” as now set forth in claim 1, lines 9-11. That is, the limitation appears to be stating that the drive unit, based on its proximity to a side wall of a frame, moves the switching device to

a cutting state selection state. Or, that the drive unit, based on the proximity of the switching device to the side wall of the frame, moves the switching device to a cutting state selection state. However, there appears to be no support in the original disclosure for such a function.

Claim Rejections - 35 USC § 112, 2nd paragraph

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 10-11, the recitation "by moving the switching device to a cutting state selection position based on proximity to a side wall of a frame" is vague and indefinite as to what is being set forth, particularly as to what structure is being set forth, for various reasons, for example, it is not clear as to what the recitation "based on proximity to a side wall of a frame" refers (i.e., what is being done based on what?), it is not clear as to what "proximity" refers (i.e., the proximity of what structure to a side wall of a frame), and it is not clear as to what frame is being set forth (i.e., a frame of what?).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3724

6. Claim 1, as understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Frisby et al., pn 4,608,891.

Frisby discloses an apparatus with every structural limitation of the claimed invention as best understood from the claim including a cutter comprising a cutting blade (e.g., 4); a switching device (e.g., 86 and the structure on which it vertically moves as described in column 4, lines 19-23); drive means (e.g., the means for moving feature 86 vertically along its support structure); and a controller (e.g., 76) that controls the drive unit.

7. Claim 1, as understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Gerber et al., pn 4,391,168 (hereafter Gerber '168).

Gerber '168 discloses an apparatus with every structural limitation of the claimed invention as best understood from the claim including a cutter comprising a cutting blade (e.g., 12); a switching device (e.g., 42, 44); drive means (e.g., the disclosed power source including 58); and a controller (e.g., 18) that controls the drive unit.

8. Claim 1, as understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Pilkington, pn 4,920,495.

Pilkington discloses an apparatus with every structural limitation of the claimed invention as best understood from the claim including a cutter comprising a cutting blade (e.g., 54); a switching device (e.g., the structure on which the blade is movably supported); drive means (e.g., 46); and a controller (e.g., 58, 60) that controls the drive unit.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2-3, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Frisby et al., pn 4,608,891.

Frisby discloses an apparatus with almost every structural limitation of the claimed invention as best understood from the claims but lacks the specific switching device configuration. However, the Examiner takes Official notice that switching devices having such a configuration are old and well known in the art and provide various known benefits including facilitating quick and easy tool positioning to different modes such as a cutting position mode, a ready position mode and a tool

Art Unit: 3724

change/maintenance mode. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a switching device on the apparatus of Frisby for the well known benefits including those described above.

11. Claims 2-3, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber et al., pn 4,391,168 (hereafter Gerber '168).

Gerber '168 discloses an apparatus with almost every structural limitation of the claimed invention as best understood from the claims but lacks the specific switching device configuration. However, the Examiner takes Official notice that switching devices having such a configuration are old and well known in the art and provide various known benefits including facilitating quick and easy tool positioning to different modes such as a cutting position mode, a ready position mode and a tool change/maintenance mode. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a switching device on the apparatus of Gerber '168 for the well known benefits including those described above.

12. Claims 2-3, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilkington, pn 4,920,495.

Pilkington discloses an apparatus with almost every structural limitation of the claimed invention as best understood from the claims but lacks the specific switching device configuration. However, the Examiner takes Official notice that switching devices having such a configuration are old and well known in the art and provide various known benefits including facilitating quick and easy tool positioning to different modes such as a cutting position mode, a ready position mode and a tool

change/maintenance mode. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a switching device on the apparatus of Pilkington for the well known benefits including those described above.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection under 35 USC 112.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3724

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
May 12, 2004